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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/808,745 | 03/15/2001 | Emanuele Ostuni | H0498/7135 TJO | 4346 |

23628 7590 03/27/2002

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| EXAMINER |
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WARE, DEBORAH K

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| ART UNIT | PAPER NUMBER |
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1651

DATE MAILED: 03/27/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/808,745

Applicant(s)
Ostuni et al.

Examiner
Ware

Art Unit
1651



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 4, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-45 are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-23 and 45, drawn to a method for patterning cells comprising 3 steps and at least 3 agents, classified in class 435, subclass 243.
 - II. Claims 24-27, drawn to a method for patterning cells comprising two steps and 2 agents applied to a second portion, classified in class 435, subclass 325.
 - III. Claims 28-34, drawn to a method for patterning cells comprising two steps and applying a 2 agents applied to a first and second portion, classified in class 435, subclass 410.
 - IV. Claims 42-44, drawn to a method comprising 3 steps and 3rd step is applying a cell and not an agent to a second portion, classified in class 424, subclass 93.1.
 - V. Claims 35-40, drawn to a method for patterning cells comprising two steps and two agents applied to just a surface of which can be the same, classified in class 424, subclass 93.7.
 - VI. Claim 41, drawn to an article comprising a first pattern of cells of a first type contiguous with a second pattern, classified in class 435, subclass 283.1.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions VI and I-V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)).

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In the instant case the processes for using an article can be practiced with another materially different product such as patterning cells in a micro tissue culture device of which may be different than the article of claim 41.

Also there is two way distinctness between each of the claimed methods of Groups I-V since each claimed group requires different combinations of agents and process steps for carrying out the respective process for patterning cells. For example, Group I requires 3 steps whereas Group II only requires two and further, more agents are required of the process of Group I than required of Group II. Also Groups I and II differ from Group III in that although only two steps are required as in Group II and Group III the agents of Group III are applied in a different way. Thus, different steps are required for each of Groups I-III and Groups IV-V since each of the groups applies the agents to different portions and the method of Group IV does not even require patterning of the cells as does Groups I-III and V. Therefore, each of the Groups demonstrate two way distinctness as discussed above and are different and distinct processes.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.


4. A telephone call was made to T. Oyer on March 21, 2002, to request an oral election to the above restriction requirement, but did not result in an election being made.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CAR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah K. Ware whose telephone number is (703) 308-4245.


DEBORAH K. WARE
PATENT EXAMINER

Deborah K. Ware

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March 22, 2002